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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/031,890
Filing Date: January 23, 2002
Appellant(s): HARPAZ, YEHOUDA

Yehouda Harpaz
Pro Se

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8-23-2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 3 and 4 under 35 U.S.C. 102(b) stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand

or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,417,425	BLUMBERG ET AL.	5-1995

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. It does not appear to be specifically disclosed in the instant specification that when an un-illuminated grid point is pressed that the points are illuminated in the player's color and are one point away from the pressed point on a line of the grid or a 45 degree diagonal becomes illuminated. Further, it does not appear to be disclosed in the instant specification that the

pressed points and all other points that are 1 or 2 points away are also illuminated on a line or 45 degree angle. Thus, the specific limitations are not disclosed in the instant specification in the same restrictive detail in which they are claimed within claim 4.

Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Blumberg et al., USPN 5,417,725.

Blumberg et al. discloses a grid of grid points on a flat surface where each grid point is a visible element, see figures 1 through 4 which is capable of detecting when it is pressed, col. 1:22-30. Blumberg et al. also discloses an illumination source inside and below the surface which is capable of illuminating the visible element, see figures 13 and 14, by either of two colors, col. 6:37-40.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation *Ex parte Masham,* 2 USPQ2d 1647 (1987). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended

use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, in the structural claim dictated by these claims, the Blumberg et al. device is capable of being used to play a variety of games and programming the device to be used in a different manner would not result in a structural difference, only a difference of a software program executed by the processor. Hence the recitation that the device be employed to play a variety of games as well as an example of such a game does not differentiate the claimed apparatus from the Blumberg et al. apparatus which satisfies the claimed structural limitation.

(11) Response to Argument

Re. Rejection of Claim 4 under 35 U.S.C. 112, first paragraph.

Appellant admits in paragraphs (2)-(4) that the text is not obvious to read, appears to state that one skilled in the art could "figure" and "work" "out" the claimed invention in claim 4 and directs the reader's attention to certain paragraphs of the instant specification for support of the language found in claim 4. The Examiner has reviewed the specification and the drawings and cannot determine where in the instant specification is language or figures that reflect what is claimed in claim 4. No where in the originally filed specification is there antecedent

basis for "45 degrees diagonal line become illuminated" as an example for the Examiner's determination of non-compliance with 112. Although, some experimentation is allowable for one skilled in the art to practice an invention that is disclosed in a patent application, that experimentation must not be undue to one of ordinary skill in the art and in the instant case given the level of one of ordinary skill in the art the experimentation needed with the originally filed application in order to practice the claimed invention of claim 4 is deemed to be undue for the limitations found therein.

Re. Rejection of Claims 3 and 4 under 35 U.S.C. 102(b)

Appellant appears to be arguing that the invention's behaviour is patentable; that every detail in claims 3 and 4 can be verified; all details of claims 3 and 4 must be included in the consideration of patentability of claims 3 and 4; that the previous "response to arguments" did not counter the "behaviour of the board" contention; claim 3 is non-obvious because an expert would have to combine many mental steps to reach the claimed invention; and it is true that the arguments used herein and through the prosecution of this application are drawn to the usage of the device.

In response to the Appellant's contentions the Examiner responses with the following:

Title 35 U.S.C. 101 lists the statutory categories of invention that patents may be obtain therefor. Respectfully, "behaviour of an invention" does not appear in the statute.

If on the other hand, the Appellant means that a machine with a specified function is patentable subject matter, this is true. However, in order to obtain the patent other sections of the code have to be met. In the instant case, the section of 102 has not been met, see the above rejection and the following: Blumberg et al discloses an electronic board (10) comprising a grid (see the figures) with a plurality of grid points (12) on a flat surface, see col. 2:44-47, "[t]he two dimensional array, which may be of any desired size, may be rectangular, but is preferably square. Square arrays of 4x4 or 5x5 are considered to be highly desirable for many applications." Each grid point being an visible element is met with figure 14; for example, which is disclosed as a LED in col. 6; but, preferably is disclosed as an LCD through the majority of the disclosure. The capability of the visible element being illuminating into two colors is met with the LCD. As shown in the figures and described in the specification for example in col. 2:55-56 the LCD lights one of two colors: lit or not lit; which is interpreted by one skilled in the art as being either the silver color or dark color depending upon whether current is being

applied to that section of the array or not. Blumberg et al. is disclosed to be used as a game, see col. 1:38:42. The recitation of the board keep a record of the player's current color is met with viewing, for example, figures 5 and 8 and understanding the disclosed invention of Blumberg. As shown in figures 5 through 8, the object of the game is to start from the way the grid points in the grid are lit as shown in figure 5 to the final picture of the grid as shown in figure 8, in as few steps as possible, in this case it would be three steps. As designated by the "+" sign, when the player presses on array element C3, said element turns dark and the array elements that are adjacent to C3 change to their opposite color. Thus, B3 and C2 go white, viewing the drawings, whereas D3 and C4 go dark or "blue", as represented by the horizontal and parallel line hash marks in the drawings, see MPEP 602.02 XI page 600-99. Thus, there is a record on the board of the player's current color, e.g. the board at C3 turn to dark while other element surrounding C3 turn opposite in color either light or dark to what they were prior to the press of C3. The recitation of when the player presses a grid point the board changes the illumination pattern of the grid points current player's color if they were switched off or reverses color if on and then changes the record of the player color is met with the

description given above and further explaining the workings of Blumberg et al. via figures 5-8. In figure 6, the player is pressing array element D3, this results in what is shown in figure 7, C3, D3, D2, D4 and E3 go reverse to light, a reversing of colors, because all were switch on or dark as shown in the figures. Thus, the board has change the illumination pattern of the grid points C3, D2, D4, E3 that surround the pressed grid point C3 and record this by the visibility of the change as shown in figure 7. The limitation of when all the grid points are switched on the board declares a winner is met by figure 8 which is have all of the grid points one color in the fewest moves.

All of the details of claims 3 and 4 have been considered regarding the patentability of the claims. See the above explanation and rejection showing how the reference anticipates claims 3 and 4.

The Examiner respectfully disagrees with the Appellant that the final Office action on the merits did not address or counter the Appellant's "behaviour of the board" contention. Page 5, second paragraph, tries to explain to the Appellant why the contention is unpersuasive.

In response to the Appellant contention that many steps would be involved and thus claim 3 is non-obvious; respectfully,

non-obviousness is not the issue. The claim is rejected under anticipation. The rejection explains how the reference meets the recitations which constitute the limitations of the claim, see above. The Appellant was suppose to reply with what limitations are not disclosed by the reference or amend the claim as a proper reply to an anticipation rejection. The number of mental steps involved to reach the invention is not an issue in this appeal or the rejection of the claims.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MON
November 8, 2004

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